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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE: U.S.S.N. 09/518,165)
)
FILED: March 1, 2000)
)
TITLE: METHOD FOR DETECTING)
PRESENCE OF TARGET)
BACTERIA OR A TARGET)
COMPONENT)
CARBOHYDRATE)
ANTIGEN THEREOF)
) GROUP ART UNIT: 1645
)
INVENTORS: V.A. Koulchin, N.J.) EXAMINER: Ja-Na Hines
Moore, E.V. Molokova)
and M.K. Fent)

PETITION PURSUANT TO 37 C.F.R. 1.181 FOR REINSTATEMENT
OF PATENT APPLICATION AND APPEAL AND RULING THAT
HOLDINGS IN EXAMINER'S "COMMUNICATION RE: APPEAL" MAILED
3/24/05 ARE NULL AND VOID

Applicants and their assignee, Binax, Inc., hereby petition for issuance of a declarative ruling herein

- a) reaffirming the petition decision of the Office of Petitions dated November 4, 2004 (Exhibit D) herein that this application has not been abandoned and that the appeal brief was timely filed under 37 C.F.R. 1.136 (a);
- b) holding that the attached "Communication Re: Appeal" (Exhibit A) is *in error* under the Rules of Practice, and especially 37 C.F.R. 1.136 (a), in (1) holding, contrary to

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the petition decision of November 4, 2004, that the appeal brief herein was not timely submitted, (2) and, in consequence thereof, was also in error in further acting (i) to dismiss the appeal and (ii) to hold the application abandoned; and

(c) requiring that all possible steps be taken forthwith to restore the active status of this application and the status of the appeal herein to the *status quo* existing as of November 5, 2004, the day immediately following the determination made herein by the Office of Petitions.

A check in the amount of \$400.00 to cover the fee for a petition under 37 C.F.R. 1.181 accompanies this petition.

I. THE FACTS

1. On March 20, 2003 a final rejection of Claims 22-52 of this application was issued by the Examiner.
2. On August 25, 2003, Applicants filed a Response, a Request Pursuant to 37 C.F.R. 1.129 for Entry and Consideration of a First Submission After Final Rejection with a check for the \$375.00 small entity fee then in effect for 37 C.F.R. §1.129 requests, a Request for Three-Month Extension of Time to Respond to the Office Action (from March 20 to and including September 22, 2003) with a check for the then extant \$465.00 small entity 3-month extension fee and a Declaration made pursuant to 37 C.F.R. 1.132 supporting facts asserted in the Response, by William J. Palin, Ph. D., a scientist with more than 35 years experience in immunology, the field of the asserted invention. In the

Response, Claims 3-22, 26, 27, 34 and 43-52 were cancelled and claims 53-59 were newly presented.

3. On December 11, 2003, a further Office Action was mailed in which, in essence, the rejections made in the March 20, 2003 final rejection were reiterated, the Palin declaration was effectively ignored and all pending claims were rejected.
4. On March 11, 2004, Applicants filed a Notice of Appeal, a check for the small-entity appeal fee of \$165 and a Request for Remand to the Examiner for clarification of the failure of the Office Action to mention the Palin Declaration¹.
5. No response to the Request for Remand was ever received. Under the prevailing rules, Applicants originally had until May 11, 2004 in which to file their Appeal Brief. However, their counsel deemed it important to obtain the benefit of the Examiner's clarification, as requested, *before* preparing that brief and hence undertook to obtain a four-month time extension for filing the brief, in the hope of receiving said clarification in the interim.
6. On Monday, September 13, 2004, (the first business day following Saturday, September 11, 2004) counsel signing this paper set out at approximately 11:10

¹ These papers erroneously refer to the December 11, 2003 paper as a "final" rejection. The error is regretted. It is noted, notwithstanding this error, that pending claims 23-25, 28-33 and 35-42 had each been rejected *more than* twice as of the date of the notice of appeal and that the appeal was, accordingly, properly taken under both 37 C.F.R. §1.191 and the provision of 35 U.S.C. §134 (a), that permits appeal if "any of...[the] claims has been twice rejected".

P.M. (when the papers were completed in her office) to deliver them to the Patent and Trademark Office window that remains open up to midnight for receipt of papers. The papers to be filed included the Appeal Brief in 3 copies, a Request for a 4-month time extension for its filing and a \$905 check to cover the small entity appeal brief fee plus the small entity 4-month time extension fee. Unfortunately, in driving from her office in downtown Washington, D.C. to Crystal City, VA so late at night, she took a wrong turn, became hopelessly lost for a long period, and eventually arrived at Crystal City about 12:10 P.M., too late to make this filing.

7. Believing the application to have thereby become unintentionally abandoned, she took all of the papers she had intended to file into her law office the following morning and commenced preparing a "Petition to Revive Unintentionally Abandoned Patent Application".
8. On September 20, 2004 she filed this Petition with 3 copies of the Appeal Brief, the check for \$905.00 dated September 13, 2004, the request for a 4-month time extension and a check for the \$665.00 small entity fee then applicable to petitions for revival of unintentionally abandoned patent applications. A copy of the Petition is appended as Exhibit B. Exhibit C is a copy of a stamped postcard which was stamped with the filing date of all papers mentioned in this paragraph, at the time of their filing by PTO personnel.
9. On or about November 8, 2004 counsel received from the Patent and Trademark Office of Petitions a November 4, 2004 decision under 37 C.F.R. 1.137 (b),

copy of which is Exhibit D hereto. The decision holds that the Appeal Brief was *not* abandoned because 37 C.F.R. 1.136 (a) permits time extensions of up to 5 months from the originally assigned date for filing an appeal brief. It also holds that since the \$665.00 *petition* fee paid was unnecessary and therefore refundable, and it more than covered the extension of time fee for the final month's time extension, payment of this latter fee could be handled by deposit of the \$665.00 into the Patent Office deposit account maintained by counsel's law firm and recoupment therefrom of the time extension fee for the fifth month, thus effecting timely payment of the fee for the additional month's time extension for filing the brief.

10. It is not known to applicants' counsel whether the Petition (Exhibit B hereto filed September 20, 2004) and the decision thereon dated November 4, 2004 (Exhibit D) were available to the Examiner who prepared the present "Communication Re: Appeal" at the time of its preparation. It is also unknown whether Exhibits B and D were available to the Supervisory Examiner who apparently signed Exhibit A as of March 24, 2005.

II. ARGUMENT

37 C.F.R. 1.181 (a) in pertinent part specifies:

(a) Petition may be taken to the Commissioner:

- (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination

proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court:

- (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and
- (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances.”

In this instance, it is unclear whether the Examiner who held this application abandoned and the Supervisory Examiner who signed the document *knew* when they so acted that a Petitions Examiner in the Office of Petitions, a part of the Office of the Deputy Commissioner for the Patent Examination Policy, had already exercised supervisory authority to hold that the Appeal Brief herein was timely filed under 37 C.F.R. 1.136 (a) and that application was never abandoned.

The Petitions Examiner is the surrogate of “the Commissioner” referred to in 37 C.F.R. 1.181 and exercises properly delegated supervisory authority with respect to interpreting any of the Patent Rules of Practice, including 37 C.F.R. §§1.136 (a) and 1.137. Neither the Examiner nor the Supervisory Patent Examiner has been delegated authority to rule upon the scope of either of these rules, or any other rule, or to interpret any rule.

The Petitions Examiner, having clearly held in Exhibit D that applicants here were entitled, upon paying the proper fee, to extend the brief’s due date to five months from May 11, 2004--i.e., to and including October 11, 2004--it must be recognized that the filing that actually occurred on September 20, 2004, accompanied by both a \$665.00 check and a \$905.00 check, (which together more than covered the entire 5-month time extension fee, as

the Petition Decision, Exhibit D, holds) satisfied the timeliness requisites of the rule as to the brief.

Moreover, the Petitions Examiner had *already* made this ruling some months prior to the issuance by the Examiner and Supervisory Patent examiner of the Exhibit A holdings (i) that the appeal brief was untimely, and (ii) hence dismissing the appeal and (iii) declaring the application abandoned. The latter rulings must hence be recognized as nullities *ab initio*, lacking in force or effect of any nature, as they *necessarily* are.

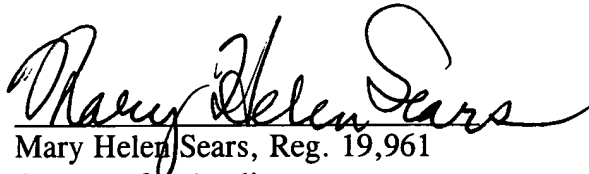
Furthermore, it is noted that the November 4, 2004 petition decision specifically provides, as of its date, that the "matter is being referred to Technology Center AU 1645" and implies, *in context*, that this referral is to permit the appeal to proceed in orderly fashion, and for *no other* purpose. It is therefore a matter of grave concern that the examiner, a member of Art Unit 1645, the Supervisory Examiner and/or other personnel in that art unit *all* failed to take account of the substance of the petition decision and issued a communication in utter defiance thereof, such as Exhibit A. This activity, viewed alone, viewed by itself, has the potential for seriously jeopardizing the rights of the applicants herein and their assignee, Binax, Inc. by causing the records of the Office to reflect falsely that the appeal is dismissed and/or the application is abandoned when, in fact, the Exhibit A "rulings" are unauthorized and incorrect.

It is accordingly requested that in deciding this petition, the person delegated by the Commissioner to so act emphasize strongly to personnel in Group Art Unit 1645 the *necessity* of their acting promptly and carefully to *insure* that *no vestige* of the null and void March 24, 2005 "Communication" is erroneously implemented in any way.

CONCLUSION

The present Petition is clearly supported by the facts that underlie it, including the November 4, 2004 decision of the Office of Petitions holding that the appeal brief herein was timely filed on September 20, 2004 and that the application was never abandoned. The attempted March 24, 2005 reversal of both these prongs of that decision by the Examiner and Supervisory Examiner is unwarranted, unauthorized, contrary to 37 C.F.R. §§ 1.136 (a) and 1.137, and should be firmly repudiated.

Respectfully submitted,

A handwritten signature in cursive script, reading "Mary Helen Sears". The signature is written in black ink and is positioned above the printed name and contact information.

Mary Helen Sears, Reg. 19,961

Attorney for Applicants

The M.H. Sears Law Firm, Chartered

910 Seventeenth Street, N.W., Suite 800

Washington, D.C. 20006

Telephone: (202) 463-3892

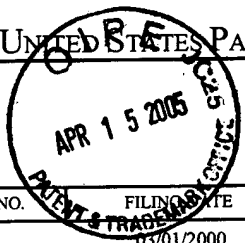
Telecopy: (202) 463-4852

E-mail: mhsears@mhsears.com



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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www.uspto.gov



APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/518,165	03/01/2000	Vladimir Andrei Koulchin		4746

Mary Helen Sears Esq
The M H Sears Law Firm Chartered
910 Seventeenth Street N W Suite 800
Washington, DC 20006

7590 03/24/2005

EXAMINER

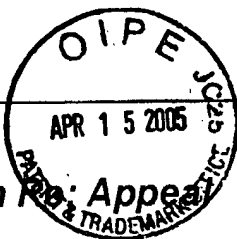
HINES, JANA A

ART UNIT PAPER NUMBER

1645

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



Communication Re: Appeal

Application No.	Applicant(s)	
09/518,165	KOULCHIN ET AL.	
Examiner	Art Unit	
Ja-Na Hines	1645	

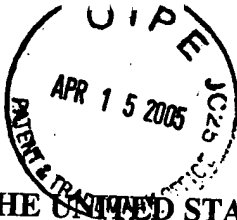
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

1. ☐ The Notice of Appeal filed on _____ is not acceptable because:
- (a) ☐ it was not timely filed.
 - (b) ☐ the statutory fee for filing the appeal was not submitted. See 37 CFR 41.20(b)(1).
 - (c) ☐ the appeal fee received on _____ was not timely filed.
 - (d) ☐ the submitted fee of \$_____ is insufficient. The appeal fee required by 37 CFR 41.20(b)(1) is \$_____.
 - (e) ☐ the appeal is not in compliance with 37 CFR 41.31(a)(1) in that no claim has been twice rejected.
 - (f) ☐ a Notice of Allowability, PTO-37, was mailed by the Office on _____.
2. ☐ The appeal brief filed on _____ is NOT acceptable for the reason(s) indicated below:
- (a) ☐ the brief and/or brief fee is untimely. See 37 CFR 41.37(a).
 - (b) ☐ the statutory fee for filing the brief has not been submitted. See 37 CFR 41.20(b)(2).
 - (c) ☐ the submitted brief fee of \$_____ is insufficient. The brief fee required by 37 CFR 41.20(b)(2) is \$_____.

The appeal in this application will be dismissed unless corrective action is taken to timely submit the brief and requisite fee. See 37 CFR 41.37(a)(1). Extensions of time may be obtained under 37 CFR 1.136(a). See 37 CFR 41.37(e).

3. ☒ The appeal in this application is DISMISSED because:
- (a) ☐ the statutory fee for filing the brief as required under 37 CFR 41.20(b)(2) was not timely submitted and the period for obtaining an extension of time to file the brief under 37 CFR 1.136(a) has expired.
 - (b) ☒ the brief was not timely filed and the period for obtaining an extension of time to file the brief under 37 CFR 1.136(a) has expired.
 - (c) ☐ a Request for Continued Examination (RCE) under 37 CFR 1.114 was filed on _____.
 - (d) ☐ other: _____.
4. ☒ Because of the dismissal of the appeal, this application:
- (a) ☒ is abandoned because there are no allowed claims.
 - (b) ☐ is before the examiner for final disposition because it contains allowed claims. Prosecution on the merits remains CLOSED.
 - (c) ☐ is before the examiner for consideration.

L. F. Smith
LYNETTE R. F. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

IN RE:	U.S.S.N. 09/518,165)	
)	
FILED:	March 1, 2000)	
)	
TITLE:	METHOD FOR DETECTING)	
	PRESENCE OF TARGET)	
	BACTERIA OR A TARGET)	
	COMPONENT)	
	CARBOHYDRATE)	
	ANTIGEN THEREOF)	
)	GROUP ART UNIT: 1645
)	
INVENTORS:	V.A. Koulchin, N.J.)	EXAMINER: Ja-Na Hines
	Moore, E.V. Molokova)	
	and M.K. Fent)	

**PETITION TO REVIVE UNINTENTIONALLY
ABANDONED PATENT APPLICATION**

This petition seeks revival of U.S. Patent Application Ser No. 09/518,165, further identified in the heading hereof.

This application became unintentionally abandoned as of 12:01 A.M. on September 13, 2004 under the circumstances set forth in the fact section below.

A check in the amount of \$665.00 to cover the small entity fee for a petition to revive an unintentionally abandoned patent application is appended hereto.

THE FACTS

1. A Notice of Appeal to the Board of Patent Appeals and Interferences was filed herein on March 11, 2004 accompanied by a check covering the small entity appeal fee of \$165.00 and a Request for Remand to Examiner interposed for the specific purpose of obtaining from her either such comments as she might advance on the Affidavit of William J. Palin, Ph. D., or an acknowledgment that she had none. This affidavit was not mentioned in the office action of December 11, 2003 even though it was a part of the papers filed in response to the immediately preceding Office Action and it contains facts asserted by Dr. Palin, (an individual who has spent some 35 years working in the field of immunology, into which the invention falls) in rebuttal to the fact positions that were earlier advanced, without any supporting evidence by the Examiner.
2. By May 11, 2004 when the Brief was originally due, I had neither received a response to my request for a limited remand nor any other information about the appeal. I considered it important for the Examiner to comment on the Palin affidavit or state that there were no comments *before* I wrote and submitted the Brief, and I accordingly decided to obtain an extension of time of 3 to 4 months for filing it, in the hope that the Examiner's comment would meanwhile be received.
3. In August 2004, I commenced writing the Brief, spending substantial time on it for 3 to 4 days, but I put it aside because of (1) my understanding that the final date for filing it was Monday, September 13, 2004 (the first business day

following Saturday, September 11, 2004)--the six-month anniversary of the filing of the notice of Appeal, (2) my hope of receiving an Examiner's comment on the Palin affidavit in the interim, and (3) a need to work on several emergency matters with deadlines in August.

4. Over the period between September 9 and September 13, including on each of Saturday, September 11 and Sunday, September 12, I worked diligently, spending a very substantial amount of time on preparation of the brief. On Monday, September 13, I again worked on the brief, and in the meantime, my staff worked on the formatting and typing thereof on our office computers. Because the brief is fairly lengthy and the first run of it required some corrections to be made , it was approximately 11:10 P.M. that day when the Brief in 3 copies, the Request for a 4-month time Extension, the \$905.00 check to cover the small entity four- month time extension fee and the and appeal brief fee, and a single handwritten post card to be stamped at filing by Patent and Trademark Office personnel were ready for me to deliver to the U.S. Patent and Trademark Office window at Crystal City that is open until midnight on each weekday from Monday through Friday that is not a national holiday.
5. I frequently deliver papers prepared in my office to the U.S. Patent and Trademark Office window referred to in the preceding paragraph for filing. My usual trips there, however, are made during rush hour and I have found that Memorial Bridge is best avoided at that time, so I circumvent it by taking Key Bridge and going through Rosslyn, taking the route that then leads along the

Potomac and into Reagan National Airport, from which I approach Crystal City on Crystal Drive.

6. Since it was between 11:15 P.M. and 11:20 P.M. when I reached my car in the garage where I normally park, and I wanted to be sure to arrive at the aforementioned window as quickly as possible, I decided to go over Memorial Bridge in the hope of getting to the window well in advance of 12:00P.M., the deadline hour.
7. Unfortunately, I am not very familiar with the route to Crystal City from that bridge, and although I made a right turn off the bridge and an immediate left turn thereafter, intending to go from there to the route along the Potomac to Reagan National Airport and into Crystal City with which I'm familiar, I somehow made an egregious error and took a wrong turn. I wound up traveling around the Pentagon, past several Pentagon exits and along the main route to Richmond, on which I could see no signs for Crystal City or Jefferson Davis Highway. As soon as I could, I made a left turn across this highway and drove off it, only to find that I was in an entirely unfamiliar area of high rise apartments. In what is best described as panic, I kept making turns toward where I estimated that Crystal City should be, to no avail, and after many such turns, I wound up at about 11:40 to 11:45 P.M. in an entirely unfamiliar, semi-industrial-seeming area of Alexandria, Virginia, where I drove around for what seemed a very long time, but could find no one from whom to seek directions and no road that looked remotely like Jefferson Davis Highway. Not until my

car clock (which is accurate by my car radio) showed 11:56 P.M., did I fortuitously find a guardhouse fronting the street with a guard in it, and I sought and was given directions to Crystal City which I followed as fast as possible, I unfortunately arrived there at about 12:10 P.M. by my car clock, too late for my papers to be accepted as of their due date.

8. My failure to get to Crystal City on time on September 13, 2004 was wholly unintentional; indeed it was contrary to every intention firmly embedded in my mind, and it has caused me great continuing mental distress to know that the result was abandonment of Application Ser. No. 09/518,165, an application I know to be very important to my client.
9. This petition to revive is accompanied by each of the following:
 - (a) three copies of the Brief of Appeal
 - (b) the request for a four month time extension and the check dated September 13, 2004 for \$905.00 to cover the \$165.00 small entity appeal brief fee and the \$740.00 small entity four month time extension fee; and
 - (c) a copy of the handwritten postcard I had intended to have stamped on September 13, 2004.
10. I state further that I know that the assignee of this patent application is very desirous that this application, which it has at no time intended to have abandoned, be revived as soon as possible.

Respectfully submitted,



Mary Helen Sears, Reg. 19,961

Attorney for Appellants

The M.H. Sears Law Firm, Chartered

910 Seventeenth Street, N.W., Suite #800

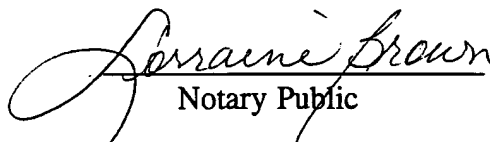
Washington, D.C. 20006

Telephone: (202) 463-3892

Telecopy: (202) 463-4852

City of Washington
District of Columbia

Subscribed and sworn to before me this 20th day of September 2004.


Notary Public

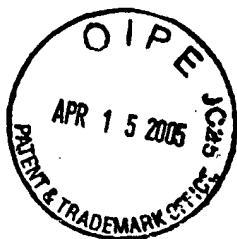
LORRAINE BROWN
NOTARY PUBLIC, DISTRICT OF COLUMBIA
MY COMMISSION EXPIRES JULY 31, 2007



Exhibit #1

Filed herewith Brief on Appeal, (3cc.)
Request for 4
month time extension
and check for
\$905 to cover
small entity
appeal brief fee
and small entity
fee for time
extension

Patent Appln. - Ser No 09/578165
Owner: Benax, Inc.



Filed
Herewith:

**PETITION TO REVIVE
PATENT APPLICATION
SERIAL NO. 09/518,165
with EXHIBIT and CHECK
for \$665.00, with
ATTACHMENTS AS
FOLLOWS: (1) Request for
4-Month Time Extension;(2)
Check for \$905.00 dated
September 13, 2004 to Cover
Appeal Brief Fee and Small
Entity 4-Month Extension
Fee; (3) Appeal Brief in 3
Copies**



*Please return this card to
address indicated on reverse*

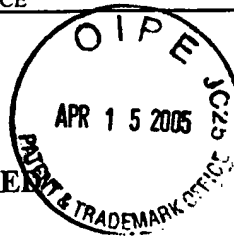
Biras - PIs file in 09/518165



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THE M H SEARS LAW FIRM CHARTERED
910 SEVENTEENTH STREET N W
SUITE 800
WASHINGTON, DC 20006



COPY MAILED

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OFFICE OF PETITIONS

In re Application of
Vladimir Andrei Koulchin et al
Application No. 09/518,165
Filed: March 1, 2000
Attorney Docket No. None

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed September 20, 2004, to revive the above-identified application.

The petition is **DISMISSED AS MOOT** for the reasons stated below.

A review of the file record discloses that a non-final Office action was mailed on December 11, 2003, setting a three month shortened statutory period for reply.

On March 11, 2004, a Notice of Appeal was timely filed. Applicants were required to file an Appeal Brief within two months of receipt in the USPTO of the Notice of Appeal, i.e., on or before May 11, 2004. However, pursuant to the provisions of 37 CFR 1.136(a), extensions of time up to five months are available. Therefore, the Appeal Brief, with the appropriate extension of time fee, is due on or before October 11, 2004. Accordingly, since this case was not in fact abandoned at the time of filing the instant petition, the petition to revive was prematurely filed and is dismissed as involving a moot issue.

Since this application was not abandoned at the time of filing of the petition to revive, as explained above, the petition to revive fee of \$665.00 is unnecessary. Accordingly, as authorized, the above fee will be credited to petitioner's Deposit Account No. 19-1027. The \$265.00 (1005.00-740.00) extension-of-time fee will be charged to the same account.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (571) 272-3220.

This matter is being referred to Technology Center AU 1645.

Wan Laymon
Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy